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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,293	07/03/2003	John Sargent French	CIRC.002C	3984
20987 7590 02/06/2007 VOLENTINE FRANCOS, & WHITT PLLC ONE FREEDOM SQUARE 11951 FREEDOM DRIVE SUITE 1260 RESTON, VA 20190			EXAMINER NGUYEN, TU T	
			ART UNIT 2886	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/06/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/613,293

Applicant(s)

FRENCH ET AL.

Examiner

Tu T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16, 18-19 of copending Application No. 10/613,299. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of the claims of

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the application are anticipated by the claims of the copending application no. 10/613,299.

With respect to claim 1, claim 1 of the application discloses the same subject matter taught in claim 1 of '299 in broader scope by removing the "sensitive module" element.

With respect to claims 2-9, the claimed limitations are disclosed in claims 1-8 of '299.

With respect to claim 10, claim 9 of '299 discloses all the limitations of claim 10 except for measuring the BER. However, measuring the BER is known in the art. it would have been obvious to modify claim 9 of '299 with the known method for measuring the BER for analyzing the condition of the DUT.

With respect to claims 11-15,17-20, the claimed limitations are disclosed by claims 10-16,18-19 of '299.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lane et al (5,148,230) in view of Joline et al (6,005,696).

With respect to claims 1, Lane discloses a testing unit for test a DUT. The unit comprises: an optical transmitter 8 (fig 1), which transmits an optical test signal that is transmitted to a DUT 6 (fig 1); an optical receiver 20 (fig 1), which receives an input signal from the DUT; a display device 32 (fig 1) which provides an interface with a user; a memory module 28 (fig 1); a controller 30,34 (fig 1), selectively coupled to said transmitter, said receiver and said display device, wherein said controller provides a central control of said transmitter, said receiver and said display device.

Lane does not explicitly disclose a graphical user interface (GUI hereinafter). Joline discloses a GUI (column 4, lines 18-30 and column 11, lines 55-65). It would have been obvious to modify Lane with the GUI as disclosed by Joline to let the user select different tests or different DUTs as taught by Joline in column 4, lines 18-30 and column 11, lines 55-65.

With respect to claim 4, Lane discloses using a memory for storing testing data utilized by the controller 30,34 (fig 1). However, Lane does not explicitly disclose a

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standard success criteria module. It would have been obvious to modify Lane with different modules for testing different characteristics of the DUT.

Claims 2,5,10-15,17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lane et al (5,148,230) in view of Joline et al (6,005,696) and Tanimoto et al (6,069,697).

With respect to claims 2,15, Lane does not disclose a calibration module. Tanimoto discloses a system comprising a calibrating process for calibrating the system (column 6). It would have been obvious to modify Lane with the calibrating process as taught by Tanimoto in column 6 to facilitate the measuring.

With respect to claims 5, Tanimoto discloses disposing the unit to a housing (column 5, line 58). It would have been obvious to modify Lane with the housing as taught by Tanimoto to reduce the system noise.

With respect to claim 10, refer to discussion in claim 1 above for the system and claim 5 above for the housing. The claimed measuring bit error rate would have been known in the art. It would have been obvious to modify Lane with the known BER method for measuring the BER of the DUT.

With respect to claims 11,18, refer to discussion in claim 1 above for the transmitter and the GUI.

With respect to claim 12, it would have been obvious to modify Lane by locating the optical receiver 20 (fig 1) within the unit to facilitate the measuring.

With respect to claim 13, refer to discussion in claim 1 above for the memory module.

With respect to claims 14, refer to discussion in claim 4 above for the testing.

With respect to claim 17, refer to discussion in claim 3 above for the standard success module.

With respect to claim 19, since Joline discloses letting the user to select different tests or different DUTs (column 4, lines 18-30 and column 11, lines 55-65), the claimed manually inputs would have been inherent. It would have been obvious to modify Joline GUI to let the users terminate the measuring to reduce unwanted testing time.

With respect to claim 20, it would have been obvious to modify Lane to perform the BER measuring after an automated calibration procedure to facilitate the testing.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lane et al (5,148,230) in view of Joline et al (6,005,696) and Coin et al (6,590,644).

With respect to claim 6, Lane does not disclose an optical power monitor. Coin discloses a system comprising a power meter 80 (fig 4). It would have been obvious to modify Lane with the power meter as disclosed in Coin to monitor the power of the signal.

Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lane et al (5,148,230) in view of Joline et al (6,005,696), Coin et al (6,590,644) and Tanimoto et al (6,069,697).

With respect to claim 7, Lane does not disclose an optical attenuator. Tanimoto discloses a system comprising an optical attenuator 2 (fig 1). It would have been obvious to modify Lane with Tanimoto's optical attenuator to control the level of the light as taught by Tanimoto in column 5, lines 40-45.

With respect to claim 8, Tanimoto discloses a control unit 12 (fig 1) for controlling the optical attenuator 2 (fig 2). It would have been obvious to modify Lane's controller to control the attenuator as taught by Tanimoto to control the testing range.

With respect to claim 9, it would have been obvious to modify Lane's controlling unit by iteratively performs the adjustments for make the system more accurate.

Allowable Subject Matter

Claims 3,16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the

base claim and any intervening claims and filed in a Terminal Disclaimer to overcome the Double Patenting rejecting above.

Prior arts of record do not disclose the claimed sensitive module as claimed in claims 3,16.

Response to Arguments

Applicant's arguments filed on 12/14/2005 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching for modifying Lane with the GUI can be found in column 4, lines 20-30 of Joline reference. The motivation is for the users to select one or more DUT to be tested. Further, Examiner also cite a new reference Rappaport (6,971,063) to show that modifying a test unit with a GUI would have been known. Rappaport discloses a test unit comprising a GUI (column 9, lines 64-67; column 10, lines 1-3 and lines 18-23) for the users selecting which network to be tested.

With respect to Applicant's argument about "the GUI is not part of the testing unit", the PC or the terminal of Joline could be considered as a part of a testing unit.

With respect to applicant's challenging about the obviousness of the method for calculating the BER, the cited references Rappaport (6,971,063) discloses a portable system for testing communication network (the network could be considered as the claimed DUT). Rappaport suggests including a measuring of BER (column 16, lines 60-65) in the portable system and Beckett (6,317,214) teaches that the communication quality of a network (or DUT) may be measured in terms of a BER (column 1, lines 15-23). It would have been obvious to modify Lane with the well known method of calculating BER taught by Rappaport for determining the quality of the DUT as taught by Beckett.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tu T. Nguyen whose telephone number is (571) 272-2424. The examiner can normally be reached on T-F 7:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Toatley Jr. can be reached on (571) 272-2800 Ext. 77. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tu T. Nguyen
Primary Examiner
Art Unit 2877

01/30/2007